REMARKS

The Office Action mailed December 22, 2008, was received and its contents carefully reviewed. Claims 1-79 were originally pending prior to the Office Action of December 22, 2008. Applicants amended claims 1, 7, 10, 20, 22, 29, 37, 43, 45, 46, 56-58, 65, and 73-75 to clarify the invention and to provide additional context to the claims. The features are disclosed at least in paragraphs [0022, 0053, 0059-0062, 0066, 0067, 0088, 0092, and 0108] and throughout the Specification and Figures. Applicants respectfully submit that no new matter was introduced by these amendments. Claims 2-6, 8, 12-19, 24-28, 30-36, 38-42, 44, 48-55, 60-64, and 66-72 have been cancelled. Applicants respectfully request reconsideration of this application in light of the above amendments and the following remarks.

Examiner Interview

Applicants acknowledge and thank Examiner Dada for his time and consideration during the telephone interview conducted with Applicants' representative and inventor Michael Raley on March 18, 2009. During the telephone interview, Applicant's representative and the inventor outlined technical differences between the present invention and the cited references and discussed claim terminology with Examiner Dada.

Claim Rejections under 35 U.S.C. § 103

Claims 1-23, 26-34, 36-59, 62-70, 72, and 76-79 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Peinado et al. U.S. Patent Number 6,816,596 ("the Peinado patent") in view of Rabin et al. U.S. Patent Number 6,697,948 ("the Rabin patent") as indicated beginning on page 4 of the December 22, 2008, Office Action. In view of the amendments above and the comments below, Applicants respectfully request reconsideration and withdrawal of this rejection because the combination of the Peinado patent and the Rabin patent fails to disclose or suggest all

the elements recited in the pending claims and fails to make the claimed invention unpatentable as obvious under 35 U.S.C. § 103(a).

As discussed in the telephone interview on March 18, 2009, the present invention is generally directed to systems and methods for the secure distribution and consumption of electronic documents using a standard rendering engine. The present invention employs a security module that is attached to a standard rendering engine to control the use of the rendering engine, leaving the rendering engine to display the digital content. The security module provides control of the rendering engine, while the rendering engine (application program) displays the content. The control is provided by the security module based on the usage rights associated with the digital content. The security module thus enforces usage rights that are not enforceable by the standard rendering engine.

The Combination of the Peinado Patent and the Rabin Patent Fails to Disclose or Suggest All the Features Recited in Amended Independent Claims 1 and 37.

Independent claims 1 of the present application recites a system for controlling use of digital content that has usage rights associated with the content. The system includes a client computer with a standard application program. The standard application program includes a rendering engine capable of being accessed to render content. See, for example, Figs. 2, 3, 7, 8, 10, and 11, and the discussions that follow in at least paragraphs [0022, 0049, 0051-0055, 0057, 0058, 0064-0072, 0078-0081, 0086-0088] and throughout the Specification discussing client computer 230.

The system of claim 1 also includes a communications network coupled to the client and the server and a client side security module that is separate from the rendering engine. See, for example, Figs. 2 and 10, and the discussions that follow in at least paragraphs [0003, 0022, 0049, 0052, 0057, 0078, 0113, 0114] and throughout the Specification discussing communications network 300. See also, Figs. 2, 5, 6, 11, 13 and the discussions that follow in at least paragraphs [0022, 0049, 0051-0062, 0064-0067, 0078-082, 0086-0092, 0098-0105, 0108, 0111, 0114] and throughout the

Specification discussing security module 237. The client side security module is downloaded and is included in the client computer. The client side security module is adapted to attach to the standard application program for enforcing security conditions for accessing the rendering engine. See also, Figs. 2, 5, 6, 11, 13 and the discussions that follow in at least paragraphs [0002, 0005, 0015, 0019, 0022, 0049, 0053, 0054, 0059, 0063, 0074] and throughout the Specification discussing Web browser 232 as a standard application program. Claim 37 is a method claim directed to similar functionality.

By using a separate client side security module and rendering engine, the present invention controls the use of digital content that has usage rights associated with it. The client side security module enforces the usage rights and manages access to the rendering engine, and the rendering engine acts upon the digital content (for example, by rendering the digital content). The security module intercepts requests to the rendering engine and determines what to do based on usage rights associated with the digital content. The present invention applies digital rights management features to standard rendering engines without requiring the rendering engines to be rewritten.

Amended claims 1 and 37 also recite that the security module determines whether the requested digital content is protected content. When the requested digital content is protected content, the security module intercepts a request to the rendering engine to render the protected digital content. When the security module determines that the requested digital content is protected content, the security module determines whether to allow a user to perform a requested function on the protected digital content based upon the usage rights associated with the protected digital content.

The security module then responds to the request to perform the requested function on the protected digital content based on the usage rights associated with the protected digital content. However, when the security module determines that the requested digital content is <u>not</u> protected content, the security module disengages from the rendering engine to preserve resources of the client computer. See Fig. 4, step 410 (step E) and paragraphs [0059-0061] for intercepting the request. See Figs. 2 and 4, regarding security module 237, UI module 234, and connection module 236 and

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paragraphs [0053-0061] for determining if the requested digital content is protected content and granting or denying the requested function based on the usage rights associated with the digital content. In this fashion, the security module may intercept requests to the rendering engine that are directed to performing functions on protected content while not impeding requests for content that is not protected.

The Peinado Patent Fails to Disclose or Suggest the Security Module with the Features Recited in Claims 1 and 37.

The Peinado patent fails to disclose or suggest the security module with the features recited in amended independent claims 1 and 37. For example, the Peinado patent does not disclose or suggest a security module that selectively intercepts a request to the rendering engine to render the digital content based upon the usage rights associated with the digital content. Instead, the Peinado patent discusses a black box that performs decryption and encryption functions for the DRM system of the Peinado patent. See col. 3, lines 26-28 of the Peinado patent. See also col. 15, lines 52-63. The black box of the Peinado patent includes a public/private key pair, a version number and a unique signature, all as provided by an approved certifying authority. See col. 3, lines 28-31 and col. 15, lines 52-63. The black box of the Peinado patent works in conjunction with a license evaluator to decrypt and encrypt information as part of a license evaluation function. See col. 15, lines 55-57.

While the Peinado patent employs a black box decryption/encryption module as part of a digital rights management system, there is no disclosure or suggestion of a security module, separate from the standard rendering engine, that determines when requested digital content is protected content based upon the usage rights of the requested digital content and then selectively intercepts requests to the standard rendering engine to render the requested digital content based upon the usage rights associated with the requested digital content. These features are not disclosed or suggested in the cited Peinado patent, nor is there any suggestion or motivation to modify the system of the Peinado patent to produce Applicants' system recited in amended independent claim 1 of the present application.

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In the Office Action mailed December 22, 2008, the Examiner concedes that the Peinado patent does not disclose a system where a security module [selectively] intercepts a request to the rendering engine to render the digital content. See the last full paragraph on page 5 of the Office Action mailed December 22, 2008. The Examiner relies upon the Rabin patent to remedy the shortcomings of the Peinado patent.

The Rabin Patent Fails to Cure the Deficiencies of the Peinado Patent.

The security module of claims 1 and 37 determines when the requested digital content is protected content and whether to allow a user to perform a requested function on the protected digital content based upon the usage rights associated with the protected digital content. The security module then responds to the request to perform the requested function on the protected digital content based on the usage rights associated with the protected digital content and disengages from the rendering engine if the requested content is not protected content to preserve resources of the client computer.

The Rabin patent, in contrast, discusses methods and an apparatus for enabling owners and vendors of software products to protect property rights of their software by employing a vendor tag system. The Rabin patent describes a system that uses a tag server that produces a plurality of tags, one per instance of software, and the tags uniquely identify an instance of software with which the tag is associated. See col. 3, lines 47-53 of the Rabin patent. A user device receives and installs an instance of software and receives a tag uniquely associated with that instance of software. See col. 3, lines 53-55. The user device includes a supervising program that detects attempts to use the instance of software and that verifies the authenticity of the tag associated with the instance of software before allowing use of the instance of software. See col. 3, lines 55-59. The supervising program on the user device verifies the authenticity of the tag and maintains or stores the tag in a tag table and maintains or stores the instance of software, if the tag is authentic. The supervising program rejects the instance of software if the tag associated with the software is not

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authentic. See col. 3, lines 59-65. The Rabin patent discusses a system for supervising usage of the software that prevents a device from employing any instance of software in a manner that is not authorized by the legitimate owner of the rights to that software. See col. 2, lines 60-65.

The Rabin patent refers to each particular copy of a piece of software as a "software instance" without regard for the type of software that is instantiated. See col. 3, lines 29-44. In the Rabin patent, no distinction is made with regard to a software program (a.k.a "software application") and a specific book or song. The Rabin patent glosses over this distinction. Yet this distinction is important in understanding the present invention such as recited in amended independent claims 1 and 37. For example, the standard rendering engine described in the present application would fall under the rubric of "software application" while a piece of digital content to be rendered would be akin or a song, or other piece of digital content. In the present invention, the security module is separate from the standard rendering engine but determines when to intercept requests to the rendering engine based upon the usage rights associated with the protected digital content which is loaded by the rendering engine.

In the Rabin patent, a tag is preferably unique to an instance of software. The tags created by the tag server include at least one of a name of an instance of software, a unique number of an instance of software, and/or a hash function value on portions of an instance of software. See col. 3, line 66 to col. 4, line 3. Preferably, the unique number of the instance of software is selected from a sparse set of numbers. In other embodiments, each tag further comprises a unique identifier of the supervising program. In yet another embodiment, each tag includes at least one fingerprint computed on portions of the instance of software associated with the tag. See col. 4, lines 4-9.

In the December 22, 2008, Office Action, the Examiner asserts that the Rabin patent discloses a security module that determines if the requested digital content is protected content based upon the usage rights associated with the requested digital content, and if the requested digital content is protected content, the security module

intercepts a request to the rendering engine. See the last full paragraph on page 5 of the Office Action mailed December 22, 2008. However, the text in the Rabin patent cited by the Examiner discloses a system with a supervising program that regulates user requests to each instance of software. That is, the intercept is not selective and is not based upon usage rights associated with the digital content. Further, there is no disclosure or suggestion of an intercept of a request to a standard rendering engine based upon usage rights of requested digital content. For example, in column 11, lines 9-34, the Rabin patent discloses:

> The step of receiving the instance of software can include the step of obtaining the instance of software at the user device. And the step of receiving the tag at a user device can include the steps of securely obtaining the tag associated with the instance of software at the user device and determining if the tag associated with the instance of software is signed, and if so, verifying a signature on a hash function value in the tag and if the signature on the hash function value is verified, installing the software on the user device, and if the tag associated with the instance of software is not signed, installing the instance of software on the user device. The step of detecting an attempt to use the instance of the software on the user device can include the steps of invoking a supervising program on the user device to intercept a user request for use of the instance of software. The step of determining if the attempt to use the instance of the software is allowable can also include the steps of determining if a call-up procedure is needed based on a call-up policy and if so performing a call-up procedure to verify the authenticity and to determine the usage supervision policy of the tag associated with the instance of software. Also included are the steps of updating tag information in the user device based upon an outcome of the call-up procedure an examining status information associated with the tag to determine if use of the instance of software associated with the tag is allowed.

See the Rabin patent at col. 11, lines 9-34 (emphasis added).

The system of the Rabin patent regulates all access to the software by intercepting all instances of software. In the Rabin patent, a software instance is received and installed, and a tag is evaluated to determine its authenticity. The usage supervision policy of the tag associated with the software is determined. In contrast, amended claim 1 of the present application recites a security module that determines

whether requested content is protected to determine whether to intercept a content request to the standard rendering engine. The security module intercepts a request to a standard rendering engine to render the digital content if the digital content is, in fact, protected. The security module then evaluates the usage rights associated with the protected digital content and responds to the request to perform a function on the protected digital content, such as rendering the content. If the rendering engine is not loaded with digital content that has usage rules, the security module does not impede the user and, in fact, disengages from the rendering engine.

Amended independent claims 1 and 37 recite determining if the content is protected and thus if a standard rendering engine is permitted to render the digital content. A user device in the system of the Rabin patent would receive the rendering engine and a tag identifying the rendering engine. If the tag matched the rendering engine, the rendering engine would be enabled. The user device would receive a piece of digital content and a second tag identifying the piece of digital content. If the second tag matched the piece of digital content, the piece of digital content would then be made available. In the Rabin patent, there is no conditional checking to regulate access based on <u>usage rules associated with the content loaded by the rendering engine</u>. The manner of regulation described in the Rabin patent is whether or not the user is authorized to use the software, not whether or not the requested action would violate the usage rules associated with the content.

There is no disclosure in the Rabin patent of a security module that selectively intercepts a request to the rendering engine based on the usage rights associated with the digital content as recited in claims 1 and 37.

Additionally, amended independent claim 1 of the present application recites that the security module disengages from the rendering engine if the requested content is not protected content to preserve resources of the client computer. See paragraph [0066] of the present specification.

Neither the Rabin patent nor the Peinado patent disclose or suggest a security module with this feature. The system of the Rabin patent regulates all access to software and maintains regulation of the software. That is, the tag checking is never

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disengaged from the rendering engine if the requested content is not protected content. As such, the system of the Rabin patent requires additional client computing resources to effect these checks.

The combination of the Rabin patent and the Peinado patent fails to disclose or suggest all the features recited in amended independent claim 1 of the present application. As such, Applicants respectfully submit that the combination of the Rabin patent and the Peinado patent fails to render claim 1 obvious under 35 U.S.C. § 103(a). Accordingly, Applicants respectfully submit that claim 1 of the present application is allowable over the combination of prior art as outlined above. Applicants respectfully request reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. § 103(a).

The Combination of the Peinado Patent and the Rabin Patent Fails to Disclose or Suggest All the Features Recited in Dependent Claims 2-23, claims 26-34, and claims 36, 76, and 77.

Dependent claims 2-23, 26-34, claim 36, 76, and 77 depend upon amended independent claim 1, and thereby include all the limitations of independent claim 1, while reciting additional features of the present invention. As noted above, Applicants amended independent claims 1 and 37 to include limitations not disclosed or suggested by the combination of the Peinado patent and the Rabin patent.

For example, the natural way to combine Rabin and Peinado would be as we see in the market today with products like Adobe Acrobat. Teachings like Rabin are used to enforce whether or not someone is authorized to run Adobe Acrobat, and whether or not they are licensed to use the Adobe Acrobat software. Acrobat in turn uses teachings like Peinado to enforce usage rules of content that is loaded by Acrobat. These usage rules pertain to how a user is authorized to use a document which is loaded by Acrobat and the rules are enforced by Acrobat.

Accordingly, with the dependency of claims 2-23, 26-34, claim 36, 76, and 77 on amended independent claims 1, Applicants respectfully submit that the combination of references also fails to disclose or suggest all of the features and

limitations of these dependent claims as well. As such, Applicant respectfully submits that the combination of references fails to render dependent claims 2-23, 26-34, claim 36, 76, and 77 obvious under 35 U.S.C. § 103(a) and that dependent claims 2-23, 26-34, claim 36, 76, and 77 are in proper condition for allowance. Applicant respectfully requests reconsideration of dependent claims 2-23, 26-34, claim 36, 76, and 77 and the withdrawal of the rejections under 35 U.S.C. § 103(a).

The Combination of the Peinado Patent and the Rabin Patent Fails to Disclose or Suggest All the Features Recited in Dependent Claims 38-59, claims 62-70, and claims 72, 78, and 79.

Dependent claims 38-59, claims 62-70, and claims 72, 78, and 79 depend upon amended independent claim 37, and thereby include all the limitations of independent claim 37, while reciting additional features of the present invention. As noted above, Applicants amended independent claims 1 and 37 to include limitations not disclosed or suggested by the combination of the Peinado patent and the Rabin patent. Accordingly, with the dependency of claims 38-59, claims 62-70, and claims 72, 78, and 79 on amended independent claims 37, Applicants respectfully submit that the combination of references also fails to disclose or suggest all of the features and limitations of these dependent claims as well. As such, Applicant respectfully submits that the combination of references fails to render dependent claims 38-59, claims 62-70, and claims 72, 78, and 79 obvious under 35 U.S.C. § 103(a) and that dependent claims 38-59, claims 62-70, and claims 72, 78, and 79 are in proper condition for allowance. Applicant respectfully requests reconsideration of dependent claims 38-59, claims 62-70, and claims 72, 78, and 79 and the withdrawal of the rejections under 35 U.S.C. § 103(a).

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The Combination of the Peinado Patent, the Rabin Patent, and the Luckenbaugh Patent Fails to Disclose or Suggest All the Features Recited in Dependent Claims 73-75.

Claims 73-75 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Peinado et al. U.S. Patent Number 6,816,596 ("the Peinado patent") in view of Rabin et al. U.S. Patent Number 6,697,948 ("the Rabin patent") and in further view of Luckenbaugh et al. U.S. Patent Number 6,311,269 ("the Luckenbaugh patent") as indicated beginning on page 8 of the December 22, 2008, Office Action. In view of the amendments above and the comments below, Applicants respectfully request reconsideration and withdrawal of this rejection because the combination of the Peinado patent, the Rabin patent, and the Luckenbaugh patent fails to disclose or suggest all the elements recited in the pending claims and fails to make the claimed invention unpatentable as obvious under 35 U.S.C. § 103(a).

Dependent claims 75-77 depend upon amended independent claim 1, and thereby include all the limitations of independent claim 1, while reciting additional features of the present invention. As noted above, Applicants amended independent claims 1 and 37 to include limitations not disclosed or suggested by the combination of the Peinado patent and the Rabin patent. Further, the Luckenbaugh patent fails to cure the deficiencies of the combination of the Peinado patent and the Rabin patent. Accordingly, with the dependency of claims 75-77 on amended independent claim 1, Applicants respectfully submit that the combination of references also fails to disclose or suggest all of the features and limitations of these dependent claims as well. As such, Applicant respectfully submits that the combination of references fails to render dependent claims 75-77 obvious under 35 U.S.C. § 103(a) and that dependent claims 75-77 are in proper condition for allowance. Applicant respectfully requests reconsideration of dependent claims 75-77 and the withdrawal of the rejections under 35 U.S.C. § 103(a).

D.   Conclusion

In view of the above amendments and remarks, Applicants respectfully request that the Examiner reconsider this application and withdraw the rejections of record. Applicants respectfully request that the Examiner allow the pending claims and pass the present application to issue.   If any issue remains after considering this response, Applicants invite the Examiner to call the undersigned to work out any such issue by telephone.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application, including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or to credit any overpayment to Deposit Account No. 19-2380. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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